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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,557	05/21/2001	Jacek Kowalski	1400.002	3728
7590	04/14/2004		EXAMINER	
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			CASIANO, ANGEL L	
		ART UNIT	PAPER NUMBER	
		2182	17	
DATE MAILED: 04/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/786,557	KOWALSKI ET AL. 
	<b>Examiner</b>	<b>Art Unit</b>
	Angel L. Casiano	2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 December 2003.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-6 and 9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6 and 9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

**DETAILED ACTION**

*Response to Amendment*

1. The present Office action is in response to Amendment dated 22 December 2003.
2. Claims 1-6 and 9 are pending in the application.

*Continued Examination Under 37 CFR 1.114*

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 December 2003 has been entered.

*Specification*

4. Objection to the Specification due to minor informalities has been overcome with the correction filed in the present Amendment.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timson et al. [US 6,041,412] in view of Kenneth et al. [US 5,594,233], in further view of Colnot [US 5,613,159].

Regarding claim 1, Timson et al. teaches a reader (see Fig. 1) for chip card (see Fig. 1, “50”, “60”). The reader includes a central processing unit (see col. 7, line 44) for emitting (see Fig. 1, “10”) and receiving (see Fig. 1, “5”) information. This communication is in a format determined by a communication protocol (see col. 8, lines 39-40) for contact chip card. The reader found in the prior art teaches a card-receiving device (see Fig. 1, “DR”) including a contact card connector (see col. 7, lines 65-66) connected to the CPU (see Fig. 1, “2”). It is also disclosed a reading device for contactless chip cards including an interface (see col. 8, lines 52-54; Fig. 2, “82”). The interface for the contactless reading device is directly connected to a communication bus (see Fig. 2). The contactless reading device is arranged in hardware (see Fig. 2) and software (see col. 8, line 62). However, the reference does not explicitly disclose a communication bus. Nonetheless, Fig. 1 teaches *emitting* and *receiving* data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the elements in Fig. 1 via a *communication bus*, since it well known in the art the use of a bus for transmission and reception purposes. Although the reference does not expressly teach the emission or reception of binary messages, one of ordinary skill in the art at the time the invention was made would have applied the reference to binary data. Transmission and reception of binary

messages is well known in the art. In addition, the reference does not teach a specific *contact chip card activation command* or a *specific activation command*. Nonetheless, the prior art teaches the activation of the contact chip card reading device and contactless card reading device. The reference also teaches responding to the activating instructions (see Figs 3, 5; col. 9, lines 1-5, 37-40). The contact and contactless chip cards *respond only to their activation signals* and devices, and not to the signal and devices intended to activate the other chip card type. In another aspect of the claim, Kenneth et al. teaches a chip card reading system having automatic recognition of the card modes (see Abstract). The chip card system disclosed teaches a response to a specific activation command (see col. 5, lines 20-23) for a contactless card. This command is different from the activation command for the contact chip card. Kenneth et al. does not explicitly cite two formats determined by a communication protocol. However, it does teach the application of a communication protocol for different card formats (see col. 2, lines 15-22). One of ordinary skill in the art would have been motivated to specify message conversion in order to properly enable data read/write functionality, as cited by Kenneth et al. The cited prior art determines the appropriate communication protocol in order to enable these functionalities. As it is well known in the art, message conversion is often required in order to obtain data compatibility. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine both references in order to have a chip card reader that automatically recognizes a contactless chip card (see Kenneth et al.; col. 2, lines 41-44). The combination of references, however, does not explicitly teach a communication bus having a *single data wire*. The combination of references also fails to teach a “contact card connector connected to the single data wire” or a “serial interface that is directly connected to the single

data wire of the communication bus", as claim 1 recites. Colnot teaches a chip card reader, where a communication bus has a *single data wire* (see col.5, lines 15-19, 39-41; col. 6, lines 18-21; col. 13, lines 45-49). In addition, the cited prior art teaches a reader for contact and contactless communication (see col. 2, lines 11-17). Accordingly, one of ordinary skill in the art would have been motivated to modify the cited combination of prior art (Timson et al. in view of Kenneth et al.) in order to implement a "bi-configuration" (see Colnot, col. 2, lines 18 and 23) for implementing a "credit or unit" system for card transactions (see Colnot).

As for claim 2, the combination of references teaches a supply wire (see Kenneth et al.; col. 1, lines 59-61). The cited wire supplies the read head electrically.

As for claim 3, the combination of references does not explicitly teach an inhibition state for the card reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device is not activated unless a signal is received (see Kenneth et al.).

As for claim 4, the combination of references teaches a central processing unit (see Timson et al.; Fig. 1, "2"). The CPU controls the card detection and activation commands (see col. 8, line 7). Nonetheless, the references do not explicitly disclose the specific operations performed by the CPU (see col. 9, lines 3-4). However, the CPU controls the contact card activation and

communication (see Fig. 3, “92”; col. 9, lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made, that in order to control as disclosed, the contact card, an activation command must have been sent and a response would have been received. Accordingly, the CPU controls the contactless card activation and its communication with the processing unit (see Fig. 3, “92”; col. 8, lines 52-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to control, as disclosed, the contactless card, an activation command must have been sent and a response would have been received (inherent, Kenneth et al.; col. 5, lines 20-24).

As for claim 5, Timson et al. does not disclose the contact card activation command as a reset command according to the ISO 7816 standard. Nonetheless, Kenneth et al. discloses an activation signal for a contact card mode (see col. 1, lines 59, 64; col. 6, lines 50, 60-61). This activation signal is a reset signal. This command is in accordance to the ISO 7816 standard (see col. 2, lines 16-22).

As for claim 6, the limitation of the specific activation command for the contactless card “likely to be never sent to a contact chip card” is taught by the combination of references. In the combination of references, the detection and activation devices for both card types are different and separated (see Figs. 1, 2, 3; col. 8, lines 52-57).

As for claim 9, the combination of references teaches the contactless reading device as integrated in a circuit arranged inside the card-receiving device (see Timson et al., Fig. 1, “DR”; see Fig. 2, “82”).

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-6 and 9 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 703-305-8301. The examiner can normally be reached on 9:30-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

alc  
13 April 2004



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